

Serial No. 09/758,835
Art Unit 1744

Amendment A

Remarks:

Responsive to the Official Action mailed May 16, 2003 Applicant respectfully requests reconsideration and allowance of claims 1-14 in view of the following remarks.

Submitted with the present AMENDMENT A is an Associate Power of Attorney appointing the undersigned to prosecute the present application.

The Examiner first notes an informal amendment relating to the replacement of identifier --12-- in place of "14" in paragraph 0024, at lines 4 and 6. Applicant acknowledges and thanks Examiner Spisich for correcting this error.

The Examiner next notes that while Applicant broadly discusses some prior art swabs, it is then stated that the swab of the present invention performs a specific function (in claim 1, lines 8-13) without specifically defining the term "electro-static dissipative material" and, more importantly, without disclosing the specific material composition of the recited swab which is supposed to function in the recited manner.

The Examiner states that for example, paragraph 0023 states that the material of the cleaning head portion can be "foam, conductive foam, micro-porous foam, polyester, sealed conductive fabric and wrapped conductive fabric", but that there is no mention of any specific types of the noted materials which are used to produce the desired effect.

The Examiner then states that for purposes of examination, the term "electro-static dissipative material" has been given the broadest reasonable interpretation in light of the list of possible materials, and that as applicant has chosen to define the claim(s) in terms of what the swab does as opposed to what it is (in the claims as well as the specification), prior art devices which meet the broad material recitations recited in the dependent claims and the specification are deemed to be capable of functioning in the recited manner.

To this end, the Examiner has rejected claims 1,5 and 6 under 35 U.S.C. 103(a) as being unpatentable over Pisacane et al., U.S. Patent No. 5,460,655 in view of the admitted prior art of paragraph 0005. The Examiner characterizes Pisacane as disclosing a swab that includes a handle on which is secured an open-cell, hydrophilic, static-dissipative, polyurethane foam. The

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Examiner states further that Pisacane discloses the invention "substantially as claimed with the exception of stating that the handle is formed of a electro-static dissipative material." The Examiner provides further that the noted paragraph in the Background section of the present application states that it is known in the art to form a cleaning swab handle of a static-dissipative material. The Examiner concludes that it would have been obvious to one of ordinary skill to have modified the handle of Pisacane as such to further dissipate any charge that may be on the surface being cleaned and that the use of "micro-porous" foams are generally known in the art, and further that the use thereof in the device of Pisacane would be obvious to one of ordinary skill based on availability, cost, etc.

The Examiner next rejected claim 2 under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 above, and further in view of Ito et al., U.S. Patent No. 4,741,066. The Examiner states that the patent to Pisacane discloses the use of a polymeric handle material and fails only to disclose the specific material, and that Ito discloses the use of a modified polybutylene terephthalate (that is along with some other constituents) and thus it would have been obvious to one of ordinary skill to have used any such material recognized by the art as suitable for implement handles based on ease of manufacture, etc.

Next, the Examiner has rejected claims 11-14 under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 above, and further in view of Halford et al., U.S. Patent No. 4,401,130. The Examiner states that the patent to Pisacane discloses a swab and fails only to disclose the foam portion in the form of a seamless "tube". However, the Examiner states that the patent to Halford discloses a cleaning swab in which the swab material is in the form of a seamless tube which is then bonded or otherwise secured to a handle. The Examiner concludes that the modification of the device of Pisacane as such would be an obvious choice of design depending on the desired article to be cleaned or for even just for sake of appearance.

Last, the Examiner has rejected claims 1, 3, 4 and 7-10 under 35 U.S.C. 103(a) as being unpatentable over Burrow et al., U.S. Patent No. 5,214,821 in view of the admitted prior art of paragraph 0005. The Examiner characterizes Burrow as disclosing a swab for cleaning electrical

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equipment in a cleanroom environment that includes a handle made of nylon and a tubular knit polyester fabric spirally wound onto the handle and thermally sealed thereto. The Examiner states further that with regard to the material of the handle, applicant's admission in paragraph 0005 states that the use of such a material is known in the art and that it would have been obvious to one of ordinary skill to have modified the device of Burrow for the same reason(s) set forth above.

Applicant would like to first point out that the functional limitations, namely "wherein the swab, in a dry state, dissipates a static electrical charge from a charge plate having a 20 picofarad capacitance at a charge of 1000 volts to a charge of less than 10 volts in less than about 500 milliseconds and in a wetted state dissipates a static electrical charge from a charge plate having a 20 picofarad capacitance at a charge of 1000 volts to a charge of less than 10 volts in less than about 100 milliseconds", are (admitted) clear and purposeful limitations of the claim. As such, it is applicant's position that these limitations must be disclosed by one or more of the prior art documents (or the admitted prior art), in order to show that the claims at issue would have been obvious to one of skill in the art at the time of the invention.

With this in mind, Applicant notes that none of the references of record disclose these functional elements or characteristics of the static dissipative material. Thus, it is Applicant's position that the Examiner has not met his burden of showing that the limitation is contained one or more of the references of record. The law has placed on the Examiner the burden to set forth a prima facie case of obviousness. This requires that the Examiner show: "(1) one or more references; (2) that were available to the inventor and; (3) that teach; (4) a suggestion to combine or modify the references; and (5) the combination of or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art." Irah H. Donner, *Patent Prosecution, Practice and Procedure Before the U.S. Patent Office*, Ch. 7.11 (2d ed. 1999).

In the present instance, the Examiner has failed to meet this burden. Specifically, the Examiner has failed to show any of the material disclosed or discussed in the prior art, and that is

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used to make swabs, includes the static dissipative characteristics claimed. Thus, at a minimum one of the claimed limitations is not disclosed in the art of record and as such the rejections under §103 are clearly improper and should be withdrawn.

Functional limitations alone are sufficient to distinguish a claimed invention over the prior art. *See, e.g.,* Donner, Ch. 7X, citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). This is not to say that the only differences between the presently claimed invention and the prior art is the claimed functional limitations. Rather, it is Applicant's position that the claimed functional limitations, without more, are sufficient to distinguish the claimed invention over the admitted prior art (discussed in the Background section of the specification), Pisacane et al., Ito et al., Halford et al. and Burrow et al., because none of these patents disclose the specific functional characteristic limitations directed the static dissipative properties of the swab.

In conclusion, it is Applicant's position that the Examiner has failed to set forth the requisite elements to show a prima facie case of obviousness. Thus, the rejections of claims 1-14 under §103 are improper and should be withdrawn, and the claims allowed to move on to allowance and issue. And, as such, Applicant submits that claims 1-14 are in fact allowable over the art of record and respectfully and earnestly solicits early indication of same.

Applicant believes that there is no fee due in connection with the present Amendment A. If, however, there is a fee due, the Commissioner is hereby authorized to charge any under-payment or credit any over-payment to Deposit Account No. 23-0920. If necessary, the present paper is to be considered any required petition.

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Should the Examiner believe that a telephone interview would expedite prosecution and allowance of the present application, or address any outstanding formal issues, he is respectfully requested to contact the undersigned.

Respectfully submitted,

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